

REMARKS

This responds to the Office Action mailed on June 23, 2006, and the references cited therewith.

Claims 1, 6 and 7 are amended, no claims are canceled, and no claims are added; as a result, claims 1-20 remain pending in this application.

§102 Rejection of the Claims

Claims 1-4, 6-9 and 11-12 were rejected under 35 U.S.C. § 102(b) for anticipation by Zelman (U.S. Patent No. 5,139,504). Applicant respectfully traverses the rejection for at least the following reasons.

The rejection states that in Zelman, a “support member 40 includes a strut connected to a cylinder, as most clearly shown in Figure 3.” The rejection further states that “the lumen of the instrument (14) has a diameter of 0.3mm -0.4mm (column 6, lines 46-48).”

Zelman appears to discuss a diameter of opening 34 (0.3mm to 0.4mm) at column 6, lines 46-48 as cited by the Examiner, however the diameter of the opening 34, by necessity is significantly smaller than a diameter of the tubular element 14 surrounding the passage. If the figures of Zelman are drawn to scale, the diameter of tubular element 14 appears to be approximately 3 times a diameter of the opening 34. Applicant respectfully submit that as discussed in the background section of the present application, a need for support in large diameter instruments was not previously recognized. Further, as discussed below, Zelman does not appear to teach a function of providing support.

Applicant is unable to find in Zelman an instrument portion with a diameter smaller than 20 gauge and a support member that engages the instrument portion along a length, providing lateral support, wherein an unsupported distal portion of the length is adjustable. In contrast, claims 1 and 7 as amended include an instrument portion with a diameter smaller than 20 gauge.

Zelman appears to show a spatula like element 40 that is slidible with respect to a body 10, within slots 48. The spatula like element 40 appears to further include a spatula tip 42 that rests against a wedge tip 26 of a tubular element 14, however the spatula tip 42 does not provide support to the tubular element 14 in any way. Any range of motion of the spatula tip 42 appears to be limited to dislodging cataractous tissue that becomes lodged in opening 34 of the wedge tip

26 (column 8, lines 8-27). A portion of the spatula like element 40 apart from the spatula tip 42 appears to be coupled to the sleeve 22 for guidance within a very narrow range of motion adjacent to the body portion 10, and does not provide *support* to any element of the instruments shown in Zelman. Applicant is unable to find in Zelman a support means that engage the small diameter instrument portion along the length, providing lateral support, and adjustment means for adjusting an amount of support for the small diameter instrument portion wherein at least one engagement location of the support means includes a location proximate to a tip of the small diameter instrument portion.

In contrast, claim 6 as amended includes a support means that engage the small diameter instrument portion along the length, providing lateral support, and adjustment means for adjusting an amount of support for the small diameter instrument portion wherein at least one engagement location of the support means includes a location proximate to a tip of the small diameter instrument portion.

Because the Zelman reference does not show every element of Applicant's independent claims, a 35 USC §102(b) rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect to Applicant's independent claims 1, 6 and 7. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

§103 Rejection of the Claims

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zelman. Applicant respectfully submits claim 10 is allowable at least as depending from an allowable base claim. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection are respectfully requested.

Reconsideration of Withdrawn Claims

In accordance with 37 CFR 1.141, Applicant respectfully requests consideration of the claims that were withdrawn as being directed to a non-elected species upon the allowance of a generic claim. Applicant respectfully asserts that all claims are now in condition for allowance.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/767,556

Filing Date: January 29, 2004

Title: SMALL GAUGE SURGICAL INSTRUMENT WITH SUPPORT DEVICE

Page 8

Dkt: 1775.001US1

Claims 1 and 6 were indicated as generic in the Restriction Requirement mailed on February 13, 2006.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

EDWIN RYAN

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6944

Date 10-23-06

By


David C. Peterson
Reg. No. 47,857

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of October, 2006.

PATRICIA A. HULTMAN

Name

Signature

